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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,181	10/05/2001	Dusan Miljkovic	700.03-USI	3749
34284	7590	07/07/2005	EXAMINER	
ROBERT D. FISH RUTAN & TUCKER LLP 611 ANTON BLVD 14TH FLOOR COSTA MESA, CA 92626-1931			OH, TAYLOR V	
			ART UNIT	PAPER NUMBER
			1625	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No. 09/972,181	Applicant(s) MILJKOVIC, DUSAN	
	Examiner Taylor Victor Oh	Art Unit 1625	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 June 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see pages 2-5. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see pages 2-5.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
 13. ☐ Other: _____.

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It is noted that applicants have filed an Amendment after the Final Rejection on 6/17/05; applicants' attorney has addressed the issues of record. The proposed amendment will not be entered because it raises new issues that would require further consideration and/or search ; and, it is not in a condition for allowance.

The Status of Claims

Claims 1-2, 5-7, 10-17, and 20 are pending.

Claims 1-2, 5-7, 10-17, and 20 are rejected.

Claim Rejections-35 USC 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-2, 5-7, 10-17, and 20 under 35 U.S.C. 112, second paragraph, has been maintained due to the applicants' failure to modify the claims .

Applicants' Argument

I. Applicants argue the following issues:

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1. It is not open-ended language that renders a claim indefinite, but the language that fails to define the metes and bounds in manner understandable to the skilled artisan in the art ;
2. The claim 1 of US 5,507,839 has the languages "...dye having a diene moiety .." and "...incorporating a dienophile into said solid material ..." only and clearly focuses on what must be present in the dye (the diene and the dienophile), but does not elaborate on other groups, or even a molecular structure of the dye and /or solid material ; therefore, the previously pending claims are sufficiently clear before amendment.
3. The applicants have revised the claims to even more strongly point out that the oxidizable groups are limited to specific groups and the remaining compound must contain the oxidizable group ; likewise, this can be applied to the metal ion the second metal containing compound .

Applicants' arguments have been noted, but the arguments are not found to be persuasive.

First, regarding the first argument, the Examiner has noted applicants' argument.

However, on the contrary to applicants' argument, it is the open-ended languages, such as "containing, including, comprising" used to describe the specific compounds in the composition claim that make the skilled artisan in the art to be confused about the metes and bounds of the claims. Furthermore, according to the case law, it is well-settled that the terms "comprising" and "containing" do not exclude the presence of other ingredients than the one or one recited. Ex parte Muench, 79 USPQ 92 (PTO Bd. App. 1948); comprising leaves the

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claim open for the inclusion of unspecified ingredients even in major mounts. Exparte Davis et al. 80 USPQ 448 (PTO Bd. App. 1948). Therefore, it is improper to use the open-ended languages, such as “containing, including, comprising” in order to describe the specific compounds.

Second, regarding the second argument, the Examiner has noted applicants' argument. However, regarding the discussion of the claim 1 of US 5,507,839, it is irrelevant to the issue, because the claim 1 has used the term “having” in the phrase of “...dye having a diene moiety ..” instead of the terms “containing, including, comprising”. The real issue is directed to the claim languages used in claims 1 and 17 (even in the revised claims), which says “a second metal –containing compound”. This is vague and indefinite because the expression of the term “containing” would imply that there are other components besides the second metal present in the compound. There is uncertainty as to what other groups are present in the compound. Furthermore, since there is no elaborated concrete chemical structure/ or chemical name for the compound, this is absolutely indefinite. Therefore, applicants' argument is irrelevant to the issue.

Third, regarding the third argument, the Examiner has noted applicants' argument. However, on the contrary to applicants' argument, the proposed amendment raises new issues that would require further consideration and/or search. Even the revised claims 1 and 17 say “a second metal –containing compound”. This is vague and indefinite because the expression of the term “containing” would imply that there are other components besides the second metal

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present in the compound. There is uncertainty as to what other groups are present in the compound. Furthermore, since there is no elaborated concrete chemical structure/ or chemical name for the compound, this is absolutely indefinite. Moreover, in claims 1 and 17, there are no concrete chemical structures / or chemical names for the first compound and the second compound and are no clear descriptions, but general remarks about the interactions of electron movements between the first compound and the second compound in explaining the complex composition. Since there is no elaborated concrete chemical structure/ or chemical name for each of the compounds, this is absolutely indefinite. Therefore, applicants' argument is still not persuasive .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Myth 10h
6/30/05

Cecilia J. Tsang
Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600